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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,436	04/10/2001	Colin P'Anson	1509-154	8765

22429 7590 01/30/2004

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,436

Applicant(s)

I'ANSON ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/829,436.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/829436, filed on 04/10/2003.

Information Disclosure Statement

The IDS as filed did not include a number of references that were listed by the applicant. The ones not contained in the IDS were not considered. These references not considered are indicated on the applicant's copy of the PTO 1449.

Drawings

The drawings filed on 04/10/2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 6 is objected to because of the following informalities: The claim wording is confusing. A word must be missing or words need to be in a different order, which with current claim makes the bounds of the claim unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claim 1, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the

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invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 8 – 17, 20, 21 and 23 are rejected under 35 U.S.C. 102(e) as being unpatentable over Esposito (US 6,587,838 B1).

Regarding claim 1 and related claims 17 and 21, Esposito teaches a shopping assistance service method, comprising the steps of: (a) capturing information about an item of interest at a business premises where the item is being offered, and sending that information to a service system (see at least Abstract, Col 2, lines 36 – 42 and Figures 2 and 4); (b) receiving the information at the service system, determining a location associated with the information, and processing the information to identify at least the type of item of interest (see at least Col 4, lines 53 – 67); (c) carrying out a specific task

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relating to the identified item and delivering an output, said location being used to organize and/or select what is in said output (see at least Col 5, lines 1 – 8 and Figures 4 and 5).

Regarding claim 2, Esposito teaches a method, wherein said location is that of the business premises where the item is being offered (Col 5, lines 1 – 6).

Regarding claim 4, Esposito teaches a method, wherein said location is a predetermined location specified by the party responsible for sending the information to the service system either in a user profile held by the service system or in said information (Abstract and Col 4, lines 61 – 63).

Regarding claim 8, Esposito teaches a method, wherein said information is sent to the service system over a mobile radio structure at the time of capture (Figure 1).

Regarding claim 9, Esposito teaches a method, wherein the captured information is stored and then subsequently sent to the service system (Col 3, lines 38 – 40 and Figure 3) and (10) wherein said data includes said location, this being the location of the business premises (Col 5, lines 1 – 8).

Regarding claim 11, Esposito teaches a method, wherein the processing of said information in step (b) involves one or more of the following operations: extracting data

from specific data fields (Col 5, lines 1 – 4); analyzing image data included in said information using OCR techniques; matching image data included in said information against stored image data; interpreting bar code image data included in said information; applying speech recognition to recorded audio data included in said information.

Regarding claim 12, Esposito teaches a method, wherein said specific task is selected by the party responsible for sending the information in step (a), the selected task being explicitly specified in said information sent to the service system (Col 5, lines 1 – 20).

Regarding claim 13, Esposito teaches a method, wherein said specific task comprises one or more of the following: - obtaining comparative pricing data for said item from other business outlets for the item and/or obtaining item-availability data concerning those business outlets; - obtaining further information about the item from a website associated with a business offering the item (Col 5, lines 30 – 34 and Figure 5); - obtaining further information about the item from internet sources; -ordering further information about the item for sending to the party responsible for step (a) .

Regarding claim 14, Esposito teaches a method, wherein said output is made available to the party responsible for step (a) in one or more of the following ways:
by return over a data channel used to the send the information to the service system in step (a) [Figures 1 and 2]; by electronic mail to a electronic mail address specified in

said information or in a user profile held by the service system in respect of said party; by print out and mailing of the print out to a physical mail address specified in said information or in a user profile held by the service system in respect of said party; by making said output available at a web site accessible by said party.

Regarding claim 15, Esposito teaches a method, wherein said item of interest is a product on offer for sale or hire (Col 5, lines 20 – 21).

Regarding claim 16, the recitation that “wherein said item of interest is a service”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “sale or hire” already disclosed by Esposito.

Regarding claim 20 and related claim 23, Esposito teaches a system according, wherein said task means comprises one or more of the following: - means for obtaining comparative pricing data for said item from other business outlets for the item and/or obtaining item-availability data concerning those business outlets; - means for obtaining further information about the item from a website associated with a business offering the item (Figures 1, 2 and 5); - means for obtaining further information about the item from internet sources; - means for ordering further information about the item for provision to the party who sent the information received by said receiving means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5 – 7, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (US 6,587,838) in view of Semple (US 6,408,307).

Esposito discloses and teaches substantially the applicant's invention.

However, Esposito does not specifically disclose and teaches a method, wherein said location is determined in one of the following ways: - by extraction from said information as specific data included by the sender; - by request to a location server of a mobile radio infrastructure through which said information has been sent to the service system from a mobile entity; by reference to a database relating business identity to location, said information including the identity of the business where the item is on offer; by processing of image data included in said information; and a method wherein step (b) involves determining multiple locations associated with said information, one said location being that of the business premises where the item is being offered and another said location being a predetermined location specified by the party responsible

for sending the information to the service system either in a user profile held by the service system or in said information; said locations all being used to organize and/or select what is in said output – as well as a method, wherein for the or each location determined in step (b), step (c) involves organizing said output according to zones of different accessibility from said location and, wherein said zones comprise at least two from the following: - a convenient walking zone around said location; - a convenient driving zone around said location; - an internet-accessible zone with delivery to said location.

On the other hand and regarding claim 3, Semple teaches a method, wherein said location is determined in one of the following ways: - by extraction from said information as specific data included by the sender; - by request to a location server of a mobile radio infrastructure through which said information has been sent to the service system from a mobile entity; by reference to a database relating business identity to location, said information including the identity of the business where the item is on offer (see at least Abstract and Figure 1); by processing of image data included in said information.

Regarding claim 5, Semple teaches a method, wherein step (b) involves determining multiple locations associated with said information, one said location being that of the business premises where the item is being offered and another said location being a predetermined location specified by the party responsible for sending the information to the service system either in a user profile held by the service system or in said

information; said locations all being used to organize and/or select what is in said output (see at least Abstract, Figure 12).

Regarding claim 6 and related claim 18, Semple teaches a method, wherein for the or each location determined in step (b), step (c) involves organizing said output according to zones of different accessibility from said location and, (7 and related claims 19 and 22) wherein said zones comprise at least two from the following: - a convenient walking zone around said location; - a convenient driving zone around said location; - an internet-accessible zone with delivery to said location (see at least Abstract, Figures 2 and 4A).

It would have been obvious to have provided the method and system of Esposito with the method and system of Semple to have enabled a method, wherein said location is determined in one of the following ways: - by extraction from said information as specific data included by the sender; - by request to a location server of a mobile radio infrastructure through which said information has been sent to the service system from a mobile entity; by reference to a database relating business identity to location, said information including the identity of the business where the item is on offer; by processing of image data included in said information; and a method wherein step (b) involves determining multiple locations associated with said information, one said location being that of the business premises where the item is being offered and another said location being a predetermined location specified by the party responsible

for sending the information to the service system either in a user profile held by the service system or in said information; said locations all being used to organize and/or select what is in said output – as well as a method, wherein for the or each location determined in step (b), step (c) involves organizing said output according to zones of different accessibility from said location and, wherein said zones comprise at least two from the following: - a convenient walking zone around said location; - a convenient driving zone around said location; - an internet-accessible zone with delivery to said location – in order to provide the recipient with the premises that are close to their location. In this manner, the probability that the customer satisfaction of the online recipient will be increased with these geo orienting features that they will return in the future for additional selections as well as recommend the site to others.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hall (US 6,026,375) and Darcie (US 6,577,714 B1), which address wireless ecommerce.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

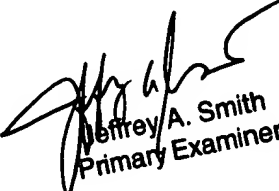
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the

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organization where this application or proceeding is assigned is (703) 872-9306 for communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER



Jeffrey A. Smith
Primary Examiner